

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	WEST <i>et al.</i>	Art Unit :	1626
Serial No. :	10/551,202	Examiner :	Rebecca L. Anderson
Filed :	June 29, 2006	Conf. No. :	4070
Title :	PHOSPHATES OF SECONDARY ALCOHOLS		

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed June 27, 2006, Applicants elect the invention of Group XX, which includes claims 5-7, insofar as those claims are drawn to methods of phosphorylating atorvastatin. The election is made with traverse.

Applicants respectfully request that the Examiner also examine the claims of Groups XXIV, XXVIII, and XXXII. The claims in these groups cover subject matter that is more limited than that of the subject matter of the elected claims. More specifically, the single claim of Group XXIV (claim 8) further limits the method of elected claim 5 by requiring "phosphorylating atorvastatin with the additional step b)" (Office action at page 4). Similarly, the claims of Group XXVIII further limit the method of elected claim 5 to one that covers "an additional method of phosphorylating atorvastatin with the additional step b')" (claim 9), and then further limit the method of claim 8 by limiting the complexing agent used in step b') (claim 11) (Office action at page 4). Group XXXII includes claim 10, which further limits the method of claim 8 by requiring additional step c), and claim 17, which limits the complexing agent used in that additional step.

It is Applicants' position that the examination of these additional groups would not impose a serious burden on the Examiner because the claims of Groups XXIV, XXVIII, and XXXII depend or ultimately depend from the independent claim in the elected Group XX. If the Examiner were to find that the step required by the method of elected Group XX were free of the prior art, it would necessarily follow that methods that include that step and other steps, would also be free of the prior art.

With respect to the special technical feature, Applicants note the Examiner's finding that "the technical feature corresponding to the claims is a phosphate derivative of a compound having a secondary hydroxyl group" (Office action at page 6). The Examiner further states,

"[t]his technical feature is not a special technical feature because it fails to define a contribution over the prior art as can be seen, for example, by WO 02/40034, which discloses phosphate derivatives of hydroxylated active compounds such as those found on pages 9 and 10 which includes secondary hydroxyl containing compounds" (Office action at page 6). In the present case, however, Applicants have elected not a phosphate derivative of a compound having a secondary hydroxyl group, but methods of making a phosphate derivative of atorvastatin. Such a derivative is not taught by WO 02/40034. Moreover, the Examiner is asked to note the findings of the International Preliminary Report on Patentability (a copy of which is attached for convenience), that "[n]one of the citations teaches or fairly suggests the preparation of a phosphorylated derivative of pravastatin, atorvastatin, venlafaxine or mixtures thereof." The special technical feature that links the claims elected with those Applicants ask to also have examined is a phosphate derivative of atorvastatin. Moreover, as required by elected claim 5, the derivative is one made by a method requiring the presence of an alkali metal salt of a fatty acid. This feature unites the methods presently divided among Groups XX, XXIV, XXVIII, and XXXII.

Applicants explicitly reserve their right to rejoin claims to the product made by the elected process claimed and to methods of using that product. As the Examiner noted in citing 37 CFR 1.475(b), "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations: ... (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product;" (Office action at page 7). Applicants have included claims to the product made by the elected process and methods of use in the Second Preliminary Amendment filed herewith. In the hope of expediting prosecution, the claims Applicants have asked the Examiner to examine are included in the Amendment together with those of elected Group XX.

Should the Examiner have any questions or wish to discuss the Applicants' position, the Examiner is invited to telephone the undersigned at the telephone number shown below.

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The fee in the amount of \$2160 for the Petition for Extension of Time is being paid herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 22380-002US1.

Respectfully submitted,

Date: March 27, 2007



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